

REMARKS

Claims 1 and 21 have been amended and claim 20 has been cancelled without prejudice or disclaimer. Claims 31, 32, 65, 113, and 117 remain withdrawn. Accordingly, claims 1, 3-5, 7-9, 11, 13-18, 20-33, 65, 113, 117, and 123 will be pending in the application upon entry of the claim amendments presented herein.

Applicants have amended claim 1 to recite that said enhancement produces a favorable chemical property selected from more complete reaction, increased efficiency, increased yield, increased rate, accelerated chemical digestion, or increased utility. Support for this amendment can be found throughout the specification, and in particular in at least page 7, lines 10-12 (paragraphs [0047] and [0048] of publication No. PCT/US2006/0057659). Claim 21 has been amended to be consistent with the amendment of claim 1 and claim 20 has been cancelled in view of the amendment to claim 1. *No new matter has been added.*

Amendment and cancellation of the claims herein is not/are not be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action and were done solely to expedite prosecution of the application. Applicants hereby reserve the right to pursue the claims as originally filed or similar claims in this or one or more subsequent patent applications.

Applicants appreciate the Examiners withdrawal of the rejections of the claims under 35 U.S.C. §102(b). However, Applicants request reconsideration of the subject application with respect to the remaining rejections based on the following remarks.

Claim Rejections – 35 U.S.C. § 103***Claims 1-9, 11-30, and 33 are rejected under 35 U.S.C. §103(a)***

Claims 1, 3-5, 7-9, 11-30, 33 and 123 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, *et al.* (WO 00/70334) in view of Zee Yong et al. (Anal. Chem. 2001, 73, 2558-2564) and Nelson (US 6,093,541). Applicants respectfully disagree and traverse the rejection.

It has been asserted in the Office Action that: (1) Lee teaches a method of solubilizing a substance using a surfactant of the invention for various spectroscopic techniques; (2) Zee-Yong et al. teach that it is known to denature a protein before digestion before spectroscopic analysis; and (3) Nelson teaches proteases for use in mass spectrometers.

Nothing in Lee, alone or in combination with Zee Yong and Nelson, suggests the instantly claimed method. As described previously, solubilization, a physical change, does not involve the digestion, alkylation or reduction of a molecule (or, as previously argued, any other chemical alteration). As such, it would be understood that there is absolutely no overlap between the prior art and the instantly pending claims.

Nevertheless, Applicants respectfully note that nothing in Lee suggests that the use of the claimed surfactants results in a favorable chemical property in reaction, such as more complete reaction, increased efficiency, increased yield, increased rate, accelerated chemical digestion, or increased utility, as now recited in claim 1. Nothing in Lee would have lead one of ordinary skill in the art to reasonably expect the enhancement of a chemical property of the alkylation or reduction reaction using these surfactants. That is to say that Lee, at best, might suggest an increase in solubility of denatured proteins using a surfactant *after the denaturation had already taken place* but would not have suggested an increase in a favorable chemical property of the reaction *during* the denaturation reaction.

Zee-Yong and/or Nelson do not recitify this deficiency as neither suggests the use of a surfactant during the denaturation reaction such that the surfactant use results in a favorable chemical property of the alkylation or reduction reaction.

To that end, the prior art does not teach or suggest all of the claim limitations, nor would there be a reasonable expectation of success in achieving the favorable chemical property based only the physical solubilization of the references cited, alone or in combination. Therefore, Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness.

Applicants submit that the teachings in WO 00/70334, whether alone or in combination with Zee-Yong et al. and/or Nelson, do not teach or suggest Applicants' claimed subject matter. As such, Applicants respectfully request that the rejections of the claims under 35 U.S.C. § 103(a) should be withdrawn.

Obviousness-type Double Patenting

Claims 1, 3-5 ,7, 22, 23, and 25-27 are provisionally rejected in view of Application No. 10/169,002. Applicants again request that this provisional rejection be held in abeyance until allowance of the instant claims, but for the obviousness-type double patenting rejection.

CONCLUSION

In view of the amendments and remarks made herein, Applicants submit that the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are respectfully requested. If a telephone conference with Applicants' representative would be helpful in expediting prosecution of the application, Applicants invite the Examiner to contact the undersigned at the telephone number indicated below.

Applicants believe that no additional fees are required in connection with this paper other than the fee for the extension of time submitted herewith. Nevertheless, Applicants authorize the Director to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to Deposit Account No. 04-1105, under Order No. 60009(49991).

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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